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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,013

04/08/2004

Paquita Erazo-Majewicz

10304

9303

7590 07/14/2008
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EXAMINER

MRUK, BRIAN P

ART UNIT

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1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,013	Applicant(s) ERAZO-MAJEWICZ ET AL.	
	Examiner Brian P. Mruk	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-76 is/are pending in the application.
- 4a) Of the above claim(s) 46-62 and 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-45 and 63-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 9, 2008 has been entered.
2. This Office action is in response to Applicant's amendment filed June 9, 2008. Applicant has amended claim 1. Claims 46-62 and 76 remain withdrawn from consideration. Currently, claims 1-19 and 21-76 remain pending in the application.
3. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office actions, Paper Nos. 20070306 and 20071204.
4. The rejection of claims 1-19, 21-45 and 63-75 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for containing the phrase "light transmittance of less than 72% at a wavelength of 600 nm" recited in instant claim 1, is withdrawn in view of applicant's amendment. Specifically, applicant

has cancelled the term "72%" from claim 1. However, a new 35 U.S.C. 112, first paragraph, rejection based on applicant's newly submitted amendment follows.

5. The rejection of claims 1-19, 21-45 and 63-75 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendments and remarks.

6. The rejection of claims 1-19, 21-45 and 63-75 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Erazo-Majewicz et al, US 2003/0211952, is maintained for the reasons of record.

7. The rejection of claims 1-19, 21-45 and 63-75 under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Erazo-Majewicz et al, WO 03/095497, is maintained for the reasons of record.

8. The rejection of claims 1-19, 21-45 and 63-75 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-56 of U.S. Patent No. 7,067,499 is maintained for the reasons of record.

9. The provisional rejection of claims 1-19, 21-45 and 63-75 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-76 of copending Application No. 11/202,469 is maintained for the reasons of record.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-19, 21-45 and 63-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the phrase “wherein the personal care or household care composition containing 2% by weight of the cationic, oxidized polysaccharide or derivative thereof has a light transmittance of less than 84% at a wavelength of 600 nm in an aqueous solution” recited in instant claim 1 is not supported by the instant specification. The examiner notes that Table 9 on page 34 of the instant specification provides for compositions with a light transmittance of 83.8, 71.6, 62, 57.7 and 43.5 at 600 nm, but this does not support the limitation “light transmittance of less than 84% at a wavelength of 600 nm” that is recited in newly amended claim 1. Furthermore, the examiner notes that Table 9 on page 34 of the instant specification provides for a composition that contains 1.82% by weight of the cationic, oxidized polysaccharide or derivative thereof, but this does not support the limitation “2% by weight of the cationic, oxidized polysaccharide or derivative thereof”

that is recited in newly amended claim 1. Appropriate correction and/or clarification is required.

Instant claims 2-19, 21-45 and 63-75 are rejected under 35 U.S.C. 112, first paragraph, for being dependent upon claim 1.

Response to Arguments

12. Applicant's arguments filed June 9, 2008 have been fully considered but they are not persuasive.

Applicant argues that Example 21 contained in Table 9, page 34 of the instant specification, provides support for the newly added limitation "wherein the personal care or household care composition containing 2% by weight of the cationic, oxidized polysaccharide or derivative thereof has a light transmittance of less than 84% at a wavelength of 600 nm in an aqueous solution" recited in instant claim 1. However, the examiner respectfully disagrees. Specifically, the examiner asserts that Example 21 contained in Table 9 on page 34 of the instant specification provides for a composition with a light transmittance of 83.8 at 600 nm, but this does not support the limitation "light transmittance of less than 84% at a wavelength of 600 nm" that is recited in newly amended claim 1. Furthermore, the examiner notes that Example 21 contained in Table 9 on page 34 of the instant specification provides for a composition that contains 1.82% by weight of the cationic, oxidized polysaccharide or derivative thereof, but this does not support the limitation "2% by weight of the cationic, oxidized polysaccharide or derivative thereof" that is recited in newly amended claim 1.

Applicant continues to argue that Erazo-Majewicz et al, US 2003/0211952, and Erazo-Majewicz et al, WO 03/095497, do not teach or suggest in general cationic oxidized polysaccharides that meet the molecular weight requirements of the instant claims. However, the examiner respectfully disagrees. Specifically, the examiner maintains that both Erazo-Majewicz et al references clearly teach cationic oxidized polysaccharides that have a molecular weight of 5,000-200,000, which are within the scope of the presently claimed invention.

Applicant further argues that Erazo-Majewicz et al, US 2003/0211952, and Erazo-Majewicz et al, WO 03/095497, each disclose compositions that deliver a clear formulation, whereas the instant claims require a light transmittance of less than 84% at a wavelength of 600 nm. However, the examiner respectfully disagrees. Specifically, the examiner asserts that both Erazo-Majewicz et al references clearly disclose that their compositions have a light transmittance in a 10% aqueous solution of greater than 80% at a light wavelength of 600 nm (see paragraph 26 of Erazo-Majewicz et al, US 2003/0211952), which are within the scope of the presently claimed invention.

Applicant further argues that the double patenting rejections over claims 1-56 of U.S. Patent No. 7,067,499 and claims 1-76 of copending Application No. 11/202,469 are overcome in view of the amendments to instant claim 1. However, the examiner respectfully disagrees. Specifically, the examiner asserts that claims 1-56 of U.S. Patent No. 7,067,499 and claims 1-76 of copending Application No. 11/202,469 disclose compositions that have a light transmittance in a 10% aqueous solution of greater than 80% at a light wavelength of 600 nm, which are within the scope of the presently

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claimed invention. Furthermore, the examiner asserts that U.S. Patent No. 7,067,499 and copending Application No. 11/202,469 claim similar cationic oxidized polysaccharides with identical molecular weights required in the instant claims, and therefore, asserts that the compositions would exhibit similar light transmittance, since products of identical chemical compositions cannot have mutually exclusive properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian P Mruk/
Primary Examiner, Art Unit 1796

Brian P Mruk
July 8, 2008

Brian P Mruk
Primary Examiner
Art Unit 1796